

Remarks:

Claims 35-40 and 43-46 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 35 and 40 are amended. Claims 41 and 42 were previously canceled. No new matter is added as support for the amendments is found within the Specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

**§103 Rejection(s):**

Claims 35-40 and 43-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over what the Examiner contends is applicant admitted prior art (hereafter “AAPA”) in view of U.S. Patent No. 6,259,935 to Saiki, et al. (hereafter “Saiki”). This rejection is respectfully traversed.

It has been long held that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Office Action continues to reject the pending claims based on AAPA in combination with Saiki without the realization that neither of the above references as used teach or suggest all the recited elements. Particularly, the Examiner fails to acknowledge that AAPA is an improper 103 reference because one of ordinary skill reading the AAPA would not be motivated to modify the AAPA in the direction of the claimed subject matter in view of Saiki.

That is, AAPA teaches a system and method of amplification that goes against the basis principals recited in the pending claims. For example, AAPA discloses an audio amplifier 12 that is external to the audio processor. The external amplifier amplifies voice (i.e., analog) signals only without regard to any signaling modes or making any distinction between whether the signal is a voice signal, ring signal or vibration signal. See figure 2, paragraphs [0010] and [0012].

In contrast, the claimed subject matter recites distinguishing between three different states and taking a different course of action in the manner the signals are processed (e.g., amplified and filtered) depending on the state that is detected. Particularly, in the first state, the audio signals are amplified in a processor of the mobile communication system; in the second state, the ring tone signals are amplified in an amplifier external to the audio processor; and in the third state, vibration signals are amplified in the amplifier external to the audio processor.

Accordingly, it is respectfully submitted that AAPA directly teaches away from the claimed subject matter by teaching that voice signals are amplified externally from the audio processor instead of from within the audio processor, as recited in claim 35. For this reason alone, AAPA even if relevant cannot be used as a primary reference, because one of ordinary skill would only in hind-sight reconstruct the AAPA to add the filtering components of Saiki. That is, the Examiner is using the Applicants invention as a roadmap to combine Saiki with the AAPA, but nothing in either of the references teaches that the AAPA can be modified in the manner the Examiner has suggested. Accordingly, AAPA should be withdrawn for being an improper reference.

It is noteworthy that Saiki also teaches away from the claimed subject matter as Saiki is directed to an electro-mechanical-acoustic transducer for converting an input electric signal into vibration, sound, or vibration and sound. The transducer applies a low-pass filter to signals to generate vibration, a high-pass filter to generate sound, and both the low-pass filter and the high-pass filter to generate vibration and sound. See Abstract; column 12, lines 5-16 and 42-46.

In other words, Saiki suggests filtering the signal by applying a low-pass filter to generate vibration. In contrast, the claimed subject matter recites the opposite approach by claiming providing a non-filtered signal to produce vibration (See claim 35). Therefore, since both references teach away from the claimed subject matter, it would be unreasonable to suggest that a person of ordinary skill in the art would have been motivated to combine Saiki with AAPA in the direction of the pending claims.

It is also further noted that Saiki fails to teach or suggest the removing of low frequency resonance components in the amplified signals that fall below a first threshold by way of the filtering. The Examiner is requested to point out portions of the reference that teach or suggest the same with more specificity. Respectfully, in absence of the Examiner's picking and choosing from among the different elements of the prior art, the result of the combination suggested by the Examiner would be a byproduct that is inconsistent with that contemplated by the claims.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to

combine with specificity,<sup>1</sup> or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.<sup>2</sup>

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn.

For the above reasons, neither AAPA nor Saiki, either alone or in combination, teach or suggest all the elements recited in claim 35. Therefore, it is respectfully submitted that claim 35 is in condition for allowance. Claims 36-39 depend on claim 35 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Amended claim 40 substantially incorporates the elements of claim 35; therefore, claim 40 and claims 43-46 depending from claim 40 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to contact the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 or [ffar-hadian@hlhlaw.com](mailto:ffar-hadian@hlhlaw.com) to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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Date: May 27, 2009

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<sup>1</sup> *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

<sup>2</sup> "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."